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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

90563-709625

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on Via EFS WEB on 8/24/11Signature /Su SteeleTyped or printed Su Steele
name

Application Number

10/694,643

Filed

October 27, 2003

First Named Inventor

William M. Reller

Art Unit

3622

Examiner

Colleen A. HOAR

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number 32,233

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34



Signature

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Typed or printed name

858-350-6100

Telephone number

August 24, 2011

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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KILPATRICK TOWNSEND & STOCKTON LLP

By: 

**AMENDMENT UNDER 37 CFR 1.116
EXPEDITED PROCEDURE –
EXAMINING GROUP 3622**

PATENT

Attorney Docket No.: 90563-709625

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

William M. Reller, et al.

Application No.: 10/694,643

Filed: October 27, 2003

For: SELECTING ADS FOR A WEB
PAGE BASED ON KEYWORDS
LOCATED ON THE WEB PAGE

Customer No.: 20350

Confirmation No. 4009

Examiner: Colleen A. Hoar

Technology Center/Art Unit: 3622

**PRE-APPEAL BRIEF REQUEST
FOR REVIEW**

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Applicants request review of the Final Office Action dated February 24, 2011 (the “Office Action”) for the above-identified application.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

STATUS OF CLAIMS

Claims 1-4, 6-30, and 32-36 are pending in the application; claims 5 and 31 were previously canceled. Claims 1, 11, 22, and 30 are independent claims. Claims 1-4, 6-30, and 32-36 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2005/0033641 to Jha in view of U.S. Patent No. 7,181,438 to Szabo.

Applicants traverse the rejection and request reconsideration and allowance of all pending claims. The claims as addressed herein correspond to the claims as per Applicants' last amendment, entered November 29, 2010.

REVIEW REQUESTED FOR THE FOLLOWING REASONS

Appellants believe that claims 1-4, 6-30, and 32-36 are allowable over the cited references without further amendment for at least the reasons provided below.

In the pending Office Action of February 24, 2011, the examiner has rejected the claims over the combination of Jha and U.S. Patent No. 7,181,438 to Szabo.

1. **The Office Action is not clear as to the features from combining Jha and Szabo that would correspond to the claimed features.**

Taking claim 1 as an example, claim 1, as last amended, recites as follows:

1. (Previously Presented) A method for selecting advertisements for presentation to client computers on a computer network, comprising:

 (a) having on a server computer a plurality of possible advertisements that may be presented to a client computer;

 (b) receiving from a client computer a request for delivery from a server of a preexisting document containing words;

 (c) determining a relevance score for keywords in the preexisting document;

(d) selecting from the plurality of advertisements a first selected ad content source for a first one of the possible advertisements and a second selected ad content source for a second one of the possible advertisements;

(e) calculating a first productivity value associated with the first selected ad source wherein the first productivity value is based on payment specified by the first selected ad content source for one or more keywords in the preexisting document and is based on the relevance score of the one or more keywords corresponding to the specified payment by the first selected ad content source;

(f) calculating a second productivity value associated with the second selected ad source wherein the second productivity value is based on payment specified by the second selected ad content source for one or more keywords in the preexisting document and is based on the relevance score of the one or more keywords corresponding to the specified payment by the second selected ad content source;

(g) comparing the first productivity value and the second productivity value and selecting the corresponding ad content source with the higher productivity value; and

(h) delivering to the client computer an advertisement from the corresponding ad content source along with the requested preexisting document in response to the received request.

The Office Action does not cite where in Jha and Szabo to find the features of (a) through (h) in claim 1. Instead, the Office Action contains a more general discussion of various features asserted to be disclosed in Jha and Szabo. It is difficult to construct a cogent argument, based on the claim features, against the discussion of Jha and Szabo in the Office Action. Applicants assert that the independent claims contain features that cannot be found in the cited references and are not described in the Office Action, and therefore the independent claims are allowable.

2. The features of the independent claims that were acknowledged to be missing from Jha are not provided by Szabo.

The examiner has withdrawn the previous rejection in which she asserted that the claims were anticipated by U.S. Patent Publication US2005/0033641 to Jha. Applicants' amendment of November 29, 2010 added features that are not possible from Jha, which features include determining a relevance score for keywords in a preexisting document, calculating productivity values based on payment (e.g. bid) specified by ad sources for one or more of the keywords, comparing the productivity values, and selecting the ad source with the greatest productivity value for delivering an advertisement. It was noted that the calculated productivity values relate to bids from the ad sources for keywords in the preexisting document, and the productivity values do not relate to content of the candidate advertisements. Jha performs filtering based on ad content.

In the pending Office Action, the examiner concedes that Jha is missing features relating to "multiple sources of ads" and asserts that Szabo discusses these features, so that the combination provides ranking "information objects" according to a "relevance ranking" and considering productivity so as to select content presentation "based on revenue opportunities from advertisers and ad content sources." The examiner concludes that therefore the combination of Jha and Szabo provide all the features of our claims. See pages 3-5 of the Office Action.

It is asserted that features cannot be located in Jha and Szabo that can be mapped onto the pending claims so as to provide the claimed features and render them obvious. For example, neither Jha nor Szabo describes operating by selecting ad content, calculating a first productivity value, calculating a second productivity value, and comparing the first productivity value and second productivity value. These features were not provided by Jha, and they are not now provided by Szabo.

It is stated in the Office Action that Szabo discusses selecting ads "based on relevant content and payment specified by advertiser (sic)" (see page 5 of the Office Action). Applicants assert that this falls short of describing or suggesting the particular features (a)

through (h) that are recited in claim 1. A similar shortcoming of the references applies to the features of the other independent claims 11, 22, and 30. Therefore, it is submitted that Jha and Szabo do not provide the features of the independent claims, and therefore the claims are patentable.

Respectfully submitted,



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